



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/976,326	10/12/2001	Stephen G. Malloy Desormeaux	83100RLW	9301

7590 07/06/2005

Milton S. Sales
Patent Legal Staff
Eastman Kodak Company
343 State Street
Rochester, NY 14650-2201

EXAMINER

JERABEK, KELLY L

ART UNIT	PAPER NUMBER
----------	--------------

2612

DATE MAILED: 07/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/976,326

Applicant(s)

MALLOY DESORMEAUX,
STEPHEN G.

Examiner

Kelly L. Jerabek

Art Unit

2612

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

Claim 9 objected to because of the following informalities: the claim includes language "concurrent with said downloading". There is insufficient antecedent basis for this limitation in the claim. Appropriate correction is required.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-20 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14, and 18-20 of copending Application No. 09/976,344 in view of Reelee et al. (US 5,619,257). This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented. It is critical that patents issuing from these applications be commonly owned to avoid potential licensees from owning license fees to two different parties.

It noted that although conflicting claims are not identical, they are not patentably distinct from each other because both claims 1-17 of the instant Application 09/976,326 (hereinafter referred to as Application '326) and claims 1-14 of copending Application 09/976,344 (hereinafter referred to as Application '344) recite a method for capturing/handling images in a camera comprising the steps of: capturing a plurality of image pairs (see capturing step of Application '344), storing the initial electronic images in memory (see storing step of Application '344), recording in association with selected image pairs of the plurality (see recording step of Application '344), changing said initial electronic images of said selected image pairs (see abridging step of Application '344). Re claims 1, 9, and 12, it is noted that the claims 1-14 of copending Application '344 do not explicitly show the step of downloading re-formatted electronic images. However, Reelee teaches downloading formatted images to a computer (col. 3, lines 1-10).

Art Unit: 2612

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the claims 1-14 of the copending Application '344 as taught by Reelee so that formatted images may be transferred externally.

Re claims 4 and 16, it is noted that the claims 1-14 of copending Application '344 do not explicitly state that the initial electronic images are restorable, however Reelee discloses that initial electronic images are restorable from formatted electronic images (Reelee is capable deleting stored images to make available memory space for new compressed images) (col. 5, line 42 – col. 6, line 9).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the claims 1-14 of the copending Application '344 as taught by Reelee so that memory space is freed for new compressed images.

Re claim 7, it is noted that claims 1-14 of the copending Application '344 do not explicitly state that the abridged electronic images require less space in memory than the initial electronic images, however Reelee discloses that abridged electronic images are compressed (col. 3, line 51 – col. 5, line 18).

Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the claims 1-14 of the copending Application '344 as taught by Reelee so that new compressed images are stored thus requiring less space in memory.

It noted that although conflicting claims are not identical, they are not patentably distinct from each other because both claims 18-20 of the instant Application '326 and

Art Unit: 2612

claims 18-20 of copending Application '344 recite a hybrid camera for use with a film unit, said camera comprising: a body, an archival image capture unit, a designator and a film writer (see assigner of '344), an electronic capture unit (see electronic subsystem of '344), a memory, a controller, and a communications port (see communications port of claim 18 of '344).

In view of the above, since the subject matters recited in the claims 1-20 of the instant application '326 is encompassed by the claims 1-14 and 18-20 of copending Application '344, allowing the claims 1-20 of the instant Application '326 would result in an unjustified or improper timewise extension of the "right to exclude" granted by a patent.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Desormeaux (US 6,505,003) discloses a hybrid camera that revises stored electronic image metadata. The information regarding latent and electronic images is relevant material.

Desormeaux (US 6,501,911) discloses a hybrid camera that downloads electronic images with reduced metadata. The information regarding latent and electronic images is relevant material.

Desormeaux (US 6,496,655) discloses a hybrid camera having optional irreversible clearance of electronic images. The information regarding latent and electronic images is relevant material.

Contacts


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kelly L. Jerabek whose telephone number is **(571) 272-7312**. The examiner can normally be reached on Monday - Friday (8:00 AM - 5:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wendy Garber can be reached on **(571) 272-7308**. The fax phone number for submitting all Official communications is 703-872-9306. The fax phone number for submitting informal communications such as drafts, proposed amendments, etc., may be faxed directly to the Examiner at **(571) 273-7312**.

Art Unit: 2612

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KLJ



AUNG MOE
PRIMARY EXAMINER